

Remarks

This is responsive to the first Office Action mailed June 14, 2005 under the RCE filed April 21, 2005. The Amendments herein are broadening in view of the cited references, are supported by the specification, do not include new matter, and do not require the Examiner to perform additional searching.

Claim Objection

Claim 19 was objected to for informalities in that it did not recite the claim from which it depends. Claim 19 has been amended herein to obviate the objection. Reconsideration and withdrawal of the objection of claim 19 are respectfully requested.

Interview Summary

The Applicant gratefully acknowledges Examiner Torres agreeing to discuss the present Office Action with Applicant's representative M. McCarthy on June 27, 2005. Agreement was reached that the stated basis for the restriction/election requirement (Office Action of 6/14/2005, pg. 3) was erroneous to the extent that the stated "Error mentoring circuit" was a typographical error which should be changed in the record to "Error monitoring circuit."

No agreement was reached in response to McCarthy's assertion that the basis was furthermore erroneous for the Examiner's statement: "the apparatus (Group I) can be used for accessing memory whereby data is stored in a different format from what it is received." This claim construction by the Examiner is discussed below as one of the bases for Applicant's traversal of the restriction/election requirement.

No agreement was reached either in response to Examiner Torres' suggestion that the restriction requirement might best be obviated by reciting the limitations of the apparatus claim verbatim within the language of the process claim.

Restriction/Election Requirement

The Examiner has invoked a restriction between the group I apparatus claims 1-14 and the group II process claims 15-27. The Applicant hereby provisionally elects the group II process claims 15-27 with traverse.

Bases for Traversal

Examiner's Erroneous Claim Construction

The restriction requirement is traversed because it is based on an erroneous construction of claim 1 by the Examiner. Particularly, the Examiner stated the following: "the apparatus (Group I) can be used for accessing memory whereby data is stored in a different format from what it is received."

Claim 1 as previously presented recited the following:

a digital data channel which stores input data to a data storage medium and subsequently retrieves output data from the medium made from the input data; and

a circuit connected to the digital data channel which can characterize the input and output data in at least two alternative digital configurations and predict error rate performance in relation to each configuration.

(excerpt of claim 1 as Previously presented, emphasis added)

The language above defines a relationship between the input and output data; that is, the output data is made from the input data. The language also recites a circuit which

can characterize the input and output data in two alternative digital configurations, and predict error rate performance in relation to each configuration. This plainly means that the input and output data can be characterized in a first configuration and a second configuration, and performance can be predicted for either the first configuration or the second configuration. If the input data is of the first configuration, then the output data is also of the first configuration because it is made from the input data; alternatively, if the input data is of the second configuration, then it necessarily follows that the output data is of the second configuration because, again, it is made from the input data.

The claim phrase "predict error rate performance in relation to each configuration" plainly means in relation to the input and output data at the first configuration or in relation to the input and output data at the second configuration. There simply is no basis for the Examiner's construction that it can mean in relation to the input at the first configuration and the output at the second configuration.

The Applicant is grateful to Examiner Torres for discussing the stated basis with Applicant's representative M. McCarthy on June 27, 2005. Examiner Torres reiterated the construction stated in the Office Action of June 14, 2005, and McCarthy agreed to disagree.

Although Applicant maintains the position that the Examiner's basis for the restriction requirement is erroneous, nevertheless the amendment to claim 1 herein is made solely to more particularly point out and distinctly claim the patentable subject matter of the present invention. Claim 1 as currently amended more particularly recites that the predicted error rate performance is in relation to *a first of the alternative digital configurations for both the input data and output data and, alternatively, to a second of the alternative digital configurations for both the input data and output data.*

Reconsideration and withdrawal of the present restriction/election requirement are respectfully requested.

Linking Claim

The restriction requirement is furthermore traversed on the basis that the Applicant has elected to add a new linking claim in means-plus-function format. (MPEP 809.03) New claim 28 is a proper linking claim written in means plus function format in accordance with 35 U.S.C. §112, sixth paragraph (MPEP 809.03). The Applicant has identified the function associated with the recited "means" element as being the prediction of error rate in a circuit storing input data and retrieving output data from a storage medium. The Examiner is obliged as a matter of law to construe this means element as the disclosed structure, and equivalents thereof, that are capable of the identical function. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. Failure to do so constitutes reversible error.

Miscellaneous

The Applicant points out that the Examiner's statement that he attempted to reach Applicant's representative M. McCarthy on 4-10-2005 to discuss the present restriction/election requirement must be wrong because the present restriction/election requirement is responsive to Applicant's RCE filed on the later date of 4-21-2005. In any event, McCarthy did not receive notice of the attempted interview but gratefully acknowledges the Examiner's attempt to do so.

Conclusion

The Applicant respectfully requests that the Examiner withdraw the restriction/election requirement and allow all of the pending claims. The Applicant is greatly concerned that even now after the first Office Action of the RCE there is yet to be a bona fide advancement in prosecution on the merits of this application. For that reason, Applicant's representative McCarthy expressly requests that the Examiner contact him by telephone to address any issues remaining that prevent all pending claims from passing to issuance.

Respectfully submitted,

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